



Dkt. 69806 CCD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Yoshifumi NOGE et al.

Serial No.: 10/634,551

Group Art Unit 1774

Filed : August 5, 2003

Examiner B.H. Hess

For : RECEIVING PAPER FOR THERMAL
TRANSFER RECORDING AND
MANUFACTURING METHOD THEREOF

PETITION

**(I) UNDER 37 C.F.R. §1.181(a)
TO WITHDRAW HOLDING OF ABANDONMENT**

or in the alternative

**(II) UNDER 37 C.F.R. §1.137(a)
TO REVIVE ABANDONED APPLICATION
FOR UNAVOIDABLE DELAY**

or further in the alternative

**(III) UNDER 37 C.F.R. §1.137(b)
TO REVIVE ABANDONED APPLICATION
FOR UNINTENTIONAL DELAY**

1185 Avenue of the Americas
New York, N.Y. 10036
October 5, 2007

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R:

This petition is submitted in response to the Notice of Abandonment dated September 26, 2007, in the above-identified application. The ground of abandonment stated in the Notice is applicants' failure to pay the issue and publication fees for the application by the due date, August 31, 2007, in response to the Notice of Allowance dated May 31, 2007.

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Submitted herewith are (1) a check in payment of the issue and publication fees totaling \$1,740.00 (the currently applicable rate) for the above-identified application, together with a completed and signed Form PTOL-85B (transmittal form); (2) Exhibits, described below, evidencing telephonic and written communications between the Examiner handling the application and applicants' attorneys of record during the period between August 20, 2007, and September 26, 2007; and (3) a statement of the pertinent facts, by applicants' undersigned attorney. Attention is also directed to the availability of papers included in the aforementioned Exhibits in the Image File Wrapper of the above-identified application on Public PAIR.

The Commissioner is hereby authorized and requested to charge any additional fees due in connection with the Petition to the deposit account of Cooper & Dunham, No. 03-3125, including, without limitation, any underpayment of the issue and publication fees and any petition fees due under 37 C.F.R. §§1.17(l), 1.17(m), 1.137(a) and 1.137(b).

(I) PETITION UNDER 37 C.F.R. § 1.181(a)

In the first instance, this is a petition to withdraw the holding of abandonment because the application was withdrawn from issue before the period originally set for payment of the issue and publication fees expired, and no new period for payment of such fees has yet been set; hence, there has been no failure to make timely payment of the issue and publication fees, and therefore the application has not become abandoned. In support of this petition, applicants submit that:

- a) On August 31, 2007, within the period for payment of the issue fee (which did not expire until the end of that day), the Examiner notified applicants' attorney Paul Teng by telephone that the application would be withdrawn from issue for rejection of claims on a reference that had been timely cited and submitted with an Information Disclosure

Statement (IDS) by applicants early in the prosecution but had not been brought to the Examiner's attention until a few days before August 31, 2007, owing to error on the part of the Patent and Trademark Office (USPTO); the Examiner added that in view of these circumstances the applicant should not pay the issue fee.

- b) Also on August 31, 2007, the Examiner sent to Mr. Teng by Facsimile a written Interview Summary (see attached EXHIBIT 3) stating that an Office Action "is being prepared which applies a reference . . . against some of applicants' claims." The Interview Summary, listed in the Transaction History and included in the Image File Wrapper of the subject application on Public PAIR with a date of August 31, 2007, constituted by necessary implication a written notice that the application was being withdrawn from issue; this notice was given prior to the original deadline (midnight, August 31, 2007) for payment of the issue and publication fees (a copy of this Interview Summary was mailed to the undersigned attorney of record on September 14, 2007).
- c) In addition, on the same day, August 31, 2007, Mr. Teng submitted a written communication (see attached EXHIBIT 4) by Facsimile transmission to the USPTO, making of record the Examiner's telephoned statements that the application would be withdrawn from issue for consideration of a reference and that in view of these circumstances, applicant should not pay the issue fee. This Communication, listed in the Transaction History and included in the Image File Wrapper of the subject application on Public PAIR with a date of August 31, 2007, constituted a further timely written record evidencing applicants' understanding that the application was being withdrawn from issue before payment of the issue fee and before the deadline set for such payment.
- d) When an application is withdrawn from issue before the deadline for payment of the issue fee, and before the fee

has been paid, it is not necessary for the applicant to pay the issue fee until a new Notice of Allowance is received. No new Notice of Allowance has yet been received, and according to Public PAIR no new Notice of Allowance has issued up to the present date in the above-identified application. Therefore, the application has not become abandoned for nonpayment of the issue and publication fees. The Notice of Abandonment should be withdrawn, and a new Notice of Allowance should be issued, setting a new due date for the issue and publication fees.

(II) ALTERNATIVE PETITION UNDER 37 C.F.R. §1.137(a)

In the alternative, if it is deemed that the application was not withdrawn from issue, this is a petition to revive the above-identified application because the delay (in payment of the issue and publication fees) that caused the abandonment was unavoidable.

The delayed required reply (payment of issue and publication fees) is submitted herewith. Authorization to charge the applicable petition fee to a deposit account is set forth above. No terminal disclaimer is required. The requisite showing of unavoidability is set forth in the statement of applicants' attorney Paul Teng (see attached EXHIBIT 4), in other Exhibits attached hereto, and in the Statement of Facts by Christopher C. Dunham set forth below.

Stated briefly, Mr. Teng was prepared to pay the issue and publication fees on August 31, 2007 and had Form PTOL-85B completed for his signature and had obtained a check for the fees (see EXHIBIT 1 attached hereto), when he received a telephone call from the Examiner in which the Examiner advised him that the application was being withdrawn from issue for preparation of a new Office Action based on previously unconsidered art, and that the issue fee need not be paid. Therefore, in reliance on the Examiner's telephoned advice (evidenced by the Examiner's Interview Summary record, EXHIBIT 3

hereto attached, and by Mr. Teng's own communication filed by Facsimile on the same day), Mr. Teng did not pay the issue fee.

Applicants submit that a delay in payment of issue and publication fees in reliance on express or implicit written advice by an Examiner that the application is being withdrawn from issue for preparation of a new Office Action, is unavoidable delay, especially where the written notice is reinforced by express telephoned advice from the Examiner that the issue fee need not be paid, which telephoned advice is timely and explicitly made a part of the written record in the USPTO file by the applicants' representative.

Moreover, a "Supplemental" Notice of Allowability was mailed on September 25, 2007, indicating on its face that a Notice of Allowance would follow (and, by necessary implication, would set a new date for payment of the issue fee). Thus, the unavoidable delay continued until applicants' undersigned attorney received the aforesaid Notice of Abandonment on October 1, 2007. The period since October 1, 2007, has been occupied in preparing this petition.

(III) ALTERNATIVE PETITION UNDER 37 C.F.R. § 1.137(b)

Further in the alternative, if the delay that caused the abandonment is not deemed to have been unavoidable, this is a petition to revive the above-identified application because the delay in payment of the issue and publication fees) that caused the abandonment was unintentional.

The delayed reply (payment of issue and publication fees) is submitted herewith. Authorization to charge the petition fee to a deposit account is set forth above. No terminal disclaimer is required.

The undersigned attorney of record hereby states that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional.

STATEMENT OF FACTS BY
CHRISTOPHER C. DUNHAM

1. I am an attorney of record in the above-identified application and am the person designated in the correspondence address of the Power of Attorney in the application.
2. On November 21, 2003, I caused to be mailed, to the United States Patent and Trademark Office (USPTO), an Information Disclosure Statement (IDS) submitting certain references which had been cited less than three months earlier in a European Search Report in applicants' counterpart European Patent Application. This IDS was received in the USPTO on November 24, 2003, before any Office Action issued in the above-identified application, and was therefore timely. A photocopy of the IDS, and a photocopy of the accompanying return card therefor showing the date received in the USPTO, are included in EXHIBIT 2 attached hereto.
3. On May 31, 2007, the USPTO mailed a Notice of Allowance of the application to me, setting a date of August 31, 2007, for payment of the issue and publication fees. This Notice of Allowance was received by me on or about June 4, 2007. A photocopy of the form PTOL-85B which accompanied the Notice of Allowance is included in EXHIBIT 1 attached hereto.
4. On or about August 17, 2007, in the course of preparing for a planned vacation that would continue until September 9, 2007, I asked my law partner, Paul Teng, an attorney registered to practice in the USPTO, to pay the issue and publication fees for the above-identified application upon receiving expected instructions from the assignee, and I delivered my file of the application into his custody. I then left for vacation and did not return to my office until September 10, 2007.
5. I am informed and believe that during my absence, on or about August 20, 2007, instructions to pay the issue and publi-

cation fees for the subject application were received by my office by Facsimile transmission from the assignee, and were brought to Mr. Teng's attention.

6. I am informed and believe that thereafter, on or before about August 23, 2007, Mr. Teng or a legal assistant working under his direction reviewed the file of the application, noted that an initialed copy of the IDS mailed November 21, 2003, had not been returned by the Examiner handling the application, inquired of the Examiner by telephone whether the IDS had been considered, and, at the request of the Examiner, transmitted a photocopy of the IDS by Facsimile to the Examiner. EXHIBIT 2 attached hereto is a photocopy of this Facsimile transmission, showing a transmission date of August 23, 2007, together with a photocopy of a subsequent Facsimile transmission cover sheet showing that a copy of the aforementioned European search report was transmitted to the Examiner on August 28, 2007. See EXHIBIT 4 attached hereto, including a photocopy of a statement of pertinent facts by Mr. Teng which was transmitted to the USPTO by Facsimile on August 31, 2007, and is in the Image File Wrapper (IFW) of the application on Public PAIR.

7. I am informed and believe that thereafter, on or before August 31, 2007, Mr. Teng prepared to pay the issue and publication fees for the subject application by having Form PTOL-85B completed for signature and causing a check in the amount of the fees to be issued by our law firm's accounting department. Photocopies of the check and of the completed but unsigned Form PTOL-85B prepared for his signature are included in EXHIBIT 1 attached hereto.

8. I am further informed and believe that on August 31, 2007, which was the due date for payment of the issue and publication fees, the Examiner telephoned Mr. Teng to advise that (in Mr. Teng's words, in the aforementioned statement included in EXHIBIT 4)

"he [the Examiner] considered the references cited in the November 21, 2003 Information Disclosure Statement, and has decided that the application will be withdrawn from issue and that he will issue an Office Action rejecting one or more claims based on one or more of the references cited in the November 21, 2003 Information Disclosure Statement. The Examiner further stated that in view of these circumstances, applicant should not pay the issue fee."

Mr. Teng's statement gives a date of "October 31, 2007," for the telephone call, but this is obviously an inadvertent error since the statement itself was transmitted to and received by the USPTO via Facsimile on August 31, 2007, as shown in the IFW copy of the statement on Public PAIR.

9. On August 31, 2007, the Examiner transmitted to Mr. Teng an Interview Summary of the telephone interview described in the preceding paragraph, as appears from the transmission line date in the photocopy of that summary included in Exhibit 3 attached hereto. In the Interview Summary (copy attached as EXHIBIT 3 hereto), the Examiner stated that "an action is being prepared which applies a reference cited on the above noted IDS against some of applicants' claims. This action will be completed after copies of all of the cited foreign patents are obtained."

10. I am further informed and believe that as a result of the August 31, 2007, telephone interview described above, Mr. Teng did not pay the issue and publication fees on that date "but instead will wait for the issuance of a new Office Action," as set forth in his statement (EXHIBIT 4) filed by Facsimile on the same day in the USPTO.

11. On or about September 10, 2007, following my return to my office from vacation, the Examiner telephoned me to arrange a telephone interview, which was held on September 12, 2007

(before the September 12 telephone interview, Mr. Teng told me of the events described in paragraphs 5 through 10 above). In the September 12, 2007, telephone interview, the Examiner explained that the November 21, 2003, IDS and the references submitted therewith did not come to his attention until August 2007, under the circumstances described in paragraph 6 above; he stated that this delay was in no way the fault of the applicants or their representative, who timely filed the IDS before the application was examined, but was instead the fault of the USPTO in failing to deliver the IDS to him. He then said that he considered that an allowed claim of the application would be subject to rejection on a reference that had been submitted with the IDS, but he proposed an amendment that he stated would render the claim allowable. I undertook to find out whether the applicants would approve the proposed amendment. Upon receiving approval from the applicants' assignee, I authorized the Examiner to make the proposed amendment by Examiner's Amendment, by telephone, on or about September 17, 2007.

12. On September 25, 2007, the USPTO mailed a "Supplemental Notice of Allowability" with an attached sheet (page 2) setting forth the Examiner's Amendment of the claims as authorized by me. This Supplemental Notice of Allowability, of which a photocopy is attached as EXHIBIT 5 hereto, was not accompanied by a new Notice of Allowance, but it stated (printed form) that "If not included herewith (or previously mailed) a Notice of Allowance . . . will be mailed in due course" and further stated (on page 2) that any amendment addressing the changes made by the Examiner "MUST be submitted no later than the payment of the issue fee."

13. On September 26, 2007, the USPTO mailed the aforesaid Notice of Abandonment (photocopy attached as EXHIBIT 6 hereto), and I received it on October 1, 2007, late in the afternoon. On October 2, 2007, I discussed the Notice of Abandonment with

the Examiner by telephone. He indicated that the applicants should proceed by petition. I thereupon undertook the preparation of this petition.

14. Before receiving the Notice of Abandonment on October 1, 2007, I did not know and did not believe that the application had become abandoned for nonpayment of the issue and publication fees by the original deadline, August 31, 2007, because I believed that the application had been withdrawn from issue on that date, prior to submission of the fees, and that a new date for payment of the fees would be set. It has always been my intention, and that of Mr. Teng, and of the applicants and their assignee, that the issue and publication fees be timely paid and that a patent issue on the application.

CONCLUSION

For the foregoing reasons, it is courteously requested that the petition be granted; that the Notice of Abandonment be withdrawn (and a new Notice of Allowance issued), or if it is not withdrawn, that the above-identified application be revived; that the payment of the issue and publication fees herewith submitted be accepted; and that a patent be granted on this application.

Respectfully,

Christopher C. Dunham
Christopher C. Dunham
Reg. No. 22,031
Attorney for Applicants
Tel. (212) 278-0400

I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Christopher C. Dunham
Christopher C. Dunham, Reg. No. 22,031
Date: OCTOBER 5, 2007